

REMARKS

Claims 1-43 are currently pending in the application, of which claims 1 and 32 are independent claims.

In view of the following Remarks, Applicants respectfully request reconsideration and timely withdrawal of the pending rejections for the reasons discussed below.

Responses to the Examiner's Arguments

The Examiner argues that *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971) permits the use of hindsight reconstruction. As the court indicated there, the Examiner must (upon finding no references that anticipate) create a combination of references while looking at the Applicants' disclosure. What is forbidden (as explained below), however, is finding the *sole* (or only genuine) motivation to combine in the Applicants' disclosure.

The Examiner does not appear to dispute the Applicants' suggestion that there is no other motivation for combining the references. The Examiner simply describes each reference, and states that the combination would be beneficial, thus it would be obvious to combine them. Applicants respectfully note that this is a flawed analysis. The fact that the claimed combination is beneficial is what is taught by the present application, not the cited references. Thus, the Examiner appears to be engaging in exactly the prohibited kind of hindsight reconstruction, in which the only basis for combining is the Applicants' disclosure.

Rejections Under 35 U.S.C. §103

Claims 1, 8-15, 25-33, and 36-43 stand rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 5,548,506 issued to Srinivasan ("*Srinivasan*") in view of U.S. Patent No. 6,223,177 issued to Tatham, *et al.* ("*Tatham*"). Applicants respectfully traverse this rejection for at least the following reasons.

In order to render a claim obvious, the combination of cited references must teach each and every element of the claimed invention and must provide teaching, motivation or suggestion to combine. Nat'l Steel Car, Ltd. v. Canadian Pac. Rwy., 357 F.3d 1319, 1337 (Fed. Cir. 2004) (citing Ecolochem, Inc. v. S. Cal. Edison Co., 227 F.3d 1361, 1371 (Fed. Cir. 2000)). This motivation must be based on the knowledge in the art, not knowledge provided by the application under examination, because such hindsight reconstruction is forbidden. In re Fine, 837 F.2d 1071, 1075 (Fed. Cir. 1988).

With regard to claim 1, the Examiner acknowledges that the primary reference does not teach at least "an administrator that prepares for automating the business process," as recited in claim 1. Office Action, p. 5. *Tatham* does not remedy the deficiencies of the primary reference. *Tatham* does not teach an administrator that prepares for automating the business process. Specifically, although *Tatham* discusses an administrator, the described administrator is not one that prepares for automating the business process. Rather, the administrator in *Tatham* accesses the system. *Tatham*, Col. 7, ll. 54-55. Accordingly, *Tatham* does not teach the element that the Examiner admits is missing from the primary reference, *Srinivasan*.

Additionally, there is no teaching, motivation, or suggestion in the art to combine the two references. In particular, *Tatham* deprecates the primary reference, *Srinivasan*, as having

disadvantages. Furthermore, the one area in which *Tatham* emphatically criticizes the prior art (its prior art, not the present application's) is the idea of having an administrator. *Tatham*, Col 1, ll. 37-40. Thus, no one would consider adding an administrator that prepares for automating the business process, because this would contradict the emphatic teaching of *Tatham*. Thus, no tertiary reference could satisfy the deficiencies of *Tatham* and *Srinivasan*.

Additionally, for the same reasons that no one would be motivated to combine *Tatham* and *Srinivasan* for the purpose of adding an administrator, to a lesser extent no one would be motivated to combine them for the purpose of supplying "monitoring the business process."

Claim 32.

The Examiner graciously admits that *Srinivasan* does not teach at least "monitoring the business process." Office Action, p. 14. *Tatham* does not remedy the deficiencies of *Srinivasan*. Particularly, *Tatham* does not teach monitoring the business process. Rather, *Tatham* teaches monitoring the workgroup size and database size. *Tatham*, Col. 5, ll. 50-51. Accordingly, *Tatham* fails to supply the deficiencies of *Srinivasan* by teaching monitoring the business process.

Accordingly, Applicants respectfully request withdrawal of the 35 U.S.C. §103(a) rejection of claims 1, 8-15, 25-33, and 36-43. Since none of the other prior art of record, whether taken alone or in any combination, discloses or suggests all the features of the claimed invention, Applicants respectfully submit that independent claims 1 and 32, and all the claims that depend from them are allowable.

Rejections Under 35 U.S.C. §103

Claims 2-7, 16-23, and 33-34 stand rejected under 35 U.S.C. §103(a) as being unpatentable over *Srinivasan* in view of Tatham and further in view of “Workgroup automation tools for end users (Software Review)” (“*Workgroup*”). Applicants respectfully traverse this rejection for at least the following reasons.

The Examiner is directed to the explanation above about why the first two cited references fail to teach the claimed invention. The deficiencies of those references are not remedied by the addition of *Workgroup*. *Workgroup* does not teach “an administrator that prepares for automating the business process” nor does it teach “monitoring the business process.” Claims 1 and 32.

Additionally, Applicants respectfully note that there is no indication that *Workgroup* is an enabling reference. The fact that *Workgroup* may describe some subject matter is not necessarily equivalent to it enabling that subject matter. Thus, *Workgroup* may not be a suitable reference even on the points the Examiner makes use of it.

Accordingly, Applicants respectfully request withdrawal of the 35 U.S.C. §103(a) rejection of claims 2-7, 16-23, and 33-34. Since none of the other prior art of record, whether taken alone or in any combination, discloses or suggests all the features of the claimed invention, Applicants respectfully submit that independent claims 1 and 32, and all the claims that depend from them are allowable.

CONCLUSION

Applicants believe that a full and complete response has been made to the pending Office Action and respectfully submits that all of the stated objections and grounds for rejection have been overcome or rendered moot. Accordingly, Applicants respectfully submit that all pending claims are allowable and that the application is in condition for allowance.

Should the Examiner feel that there are any issues outstanding after consideration of this response, the Examiner is invited to contact the Applicants' undersigned representative at the number below to expedite prosecution.

Prompt and favorable consideration of this Reply is respectfully requested.

Respectfully submitted,



Richard Schachner
Reg. No. 48,342

Hae-Chan Park
Reg. No. 50,114

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McGuireWoods LLP
1750 Tysons Boulevard
Suite 1800
McLean, VA 22102-4215
Tel: 703-712-5365
Fax: 703-712-5280
HCP:PCF